

REMARKS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 11-14, 19, and 20 are presently active in this case, Claims 11 and 12 having been amended and Claims 1-10, 15-18, and 21-31 having been canceled by way of the present Amendment.

The Applicants acknowledge with appreciation the withdrawal of the species restriction between the articles. The Applicants note that the restriction requirement set forth in the outstanding Office Action has been responded to in the response filed on February 1, 2002.

In the outstanding Official Action, Claims 11-14 were rejected under 35 U.S.C. 102(e) as being anticipated by Jackson et al. (U.S. Patent No. 6,100,513). For the reasons discussed below, the Applicants request the withdrawal of the anticipatory rejection.

Claim 11 of the present application advantageously recites a backing sheet for insulation including a first side having an adherent material thereon, a second side, and a stapling tab extending along an edge of the backing sheet. The first side and the adherent material are adapted to receive a sheet of fiberglass material. The stapling tab is defined as having a first portion of the second side positioned against a second portion of the second side. The backing sheet further includes a tacky substance bonding the first portion of the second side and the second portion of the second side. The Applicants respectfully submit that the Jackson et al. reference does not disclose all of the limitations recited in Claim 11, and therefore does not anticipate Claim 11.

The Jackson et al. reference describes a microwave popcorn package that includes a sheet construction of flexible paper folded in the form of an expandable bag. The bag

preferably includes an inner ply (46) and an outer ply (47) with a laminating adhesive (165) provided between the plies, as depicted in Figure 2. The Official Action cites the laminating adhesive (165) for the teaching of the tacky substance recited in Claim 11 of the present application, however the Applicants note that the laminating adhesive (165) does not bond a first portion of a side of one of the plies (46 or 47) to a second portion of the same side of the same ply. The laminating adhesive (165) does not bond a side of one of the plies to itself, but rather the laminating adhesive (165) bonds the inner ply (46) to the outer ply (47) and imparts a greaseproof character to the flexible paper of the bag. (See column 14, lines 35-59, of the Jackson et al. reference.)

The Applicants further note that Claim 11 of the present application recites a backing sheet for insulation, which is neither disclosed or suggested by the Jackson et al. reference. To the contrary, the Jackson et al. reference describes a microwave popcorn package that includes adhesive to provide a grease-resistant character to the package. The Jackson et al. reference does not disclose a backing sheet for insulation including a first side having an adherent material thereon, where the first side and the adherent material are adapted to receive a sheet of fiberglass material.

Accordingly, the Applicants respectfully submit that Claim 11 is not anticipated by the Jackson et al. reference.

Claims 12-14 are considered allowable for the reasons advanced for Claim 11 from which they depend. These claims are further considered allowable as they recite other features of the invention that are neither disclosed, taught, nor suggested by the applied references when those features are considered within the context of Claim 11.

Claims 19 and 20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson et al. in view of Jorgenson et al. (U.S. Patent No. 5,713,885). For the reasons discussed below, the Applicants traverse the obviousness rejection.

The basic requirements for establishing a *prima facie* case of obviousness as set forth in MPEP 2143 include (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the reference (or references when combined) must teach or suggest all of the claim limitations.

The Applicant submits that a *prima facie* case of obviousness has not been established in the present case because (1) the references, either singularly or in combination, do not teach or suggest all of the claim limitations, and (2) there is no suggestion or motivation to combine the references.

Claim 19 of the present application advantageously recites a backing sheet for insulation including a first side having an adherent material thereon, a second side, and a stapling tab extending along an edge of the backing sheet. The stapling tab is defined as having a first portion of the second side positioned against a second portion of the second side. The backing sheet further includes at least one hole extending through the backing sheet such that a portion of the adherent material extends through the at least one hole and contacts the second side.

As discussed above, the Jackson et al. reference describes a microwave popcorn package that includes a sheet construction of flexible paper folded in the form of an expandable bag. The Jackson et al. reference is primarily concerned with providing a packaging bag that is greaseproof, such that the bag does not allow grease within the bag to

seep through the bag. The Jackson et al. reference does not disclose a backing sheet including at least one hole extending through the backing sheet such that a portion of the adherent material extends through the at least one hole and contacts the second side of the backing sheet, and in fact the Jackson et al. reference teaches away from such a hole since the hole might allow grease to leak through the bag. The Applicants further note the Jackson et al. reference is directed toward a microwave popcorn package, rather than a backing sheet for insulation, as recited in Claim 19 of the present application.

The Jorgenson et al. reference is cited for the teaching of the at least one hole recited in Claim 19 of the present application. The Jorgenson et al. reference describes an absorbent article having a liquid-permeable cover, a liquid-impermeable baffle, and an absorbent with longitudinal side portions positioned intermediate thereof. The Jorgenson et al. reference states that the liquid-permeable cover (126) can contain a plurality of apertures to allow liquid to pass through the cover (126).

The Applicants submit that the Jorgenson et al. reference clearly does not disclose or suggest a backing sheet including at least one hole extending through the backing sheet such that a portion of the adherent material extends through the at least one hole and contacts the second side of the backing sheet, as recited in Claim 19. The apertures briefly mentioned in the Jorgenson et al. reference do not have adherent material extending therethrough in the manner expressly recited in Claim 19 of the present application. Accordingly, neither of the cited references teach this limitation of Claim 19.

Furthermore, the Applicants submit that one of ordinary skill in the art would not have been motivated to combine the teachings of the Jorgenson et al. reference with the teachings of the Jackson et al. reference in the manner suggested in the Official Action. The Jackson et al. and Jorgenson et al. references are directed to vastly different arts (greaseproof

microwave popcorn packages versus absorbent sanitary napkins), which also are not analogous to the art of the present invention. The structures describes in the Jackson et al. and Jorgenson et al. references are provided to perform vastly different functions that are in many ways contrary to one another. For example, the Jackson et al. reference teaches away from the use of an aperture therethrough, since the aperture might allow grease to leak through the bag, which would be contrary to the stated goals of the Jackson et al. reference to provide a package that prevents the leakage of grease.

The Applicants, therefore, respectfully submit that the rejection is based on the improper application of hindsight considerations. It is well settled that it is impermissible simply to engage in hindsight reconstruction of the claimed invention, using Applicants' structure as a template and selecting elements from the references to fill in the gaps. *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991). Recognizing, after the fact, that a modification of the prior art would provide an improvement or advantage, without suggestion thereof by the prior art, rather than dictating a conclusion of obviousness, is an indication of improper application of hindsight considerations. Simplicity and hindsight are not proper criteria for resolving obviousness. *In re Warner*, 397 F.2d 1011, 154 USPQ 173 (CCPA 1967).

Therefore, the Applicants respectfully submit that Claim 19 is not rendered obvious in light of the teachings of the Jackson et al. and Jorgenson et al. references.

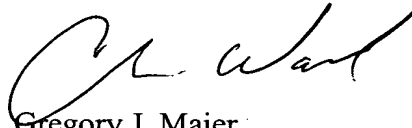
Claim 20 is considered allowable for the reasons advanced for Claim 19 from which it depends. This claim is further considered allowable as it recites other features of the invention that are neither disclosed, taught, nor suggested by the applied references when those features are considered within the context of Claim 19.

Accordingly, the Applicants respectfully request the withdrawal of the obviousness rejection.

Consequently, in view of the above discussion, it is respectfully submitted that Claims 11-14 and 19-20 are patentably distinguishing over the cited art. The present application is therefore believed to be in condition for formal allowance and an early and favorable reconsideration of this application is therefore requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Gregory J. Maier
Attorney of Record
Registration No. 25,599
Christopher D. Ward
Registration No. 41,367



22850

Tel. (703) 413-3000
Fax. (703) 413-2220
(OSMMN 11/98)

GJM/CDW/brf
I:\atty\cdw\192400US55X\aml.wpd

Marked-Up Copy

Serial No: 09/675,180

Amendment Filed on: 6-12-02

IN THE CLAIMS

Claims 1-10 (Cancel)

11. (Once Amended) A backing sheet for insulation, said backing sheet comprising:
a first side having an adherent material thereon, said first side and said adherent material being adapted to receive a sheet of fiberglass material;

a second side;

a stapling tab extending along an edge of said backing sheet, said stapling tab having a first portion of said second side positioned against a second portion of said second side; and

a tacky substance [between] bonding said first portion of said second side and said second portion of said second side.

12. (Once Amended) The backing sheet according to Claim 11, wherein said stapling tab comprises:

a first fold extending along an edge of said backing sheet, said first fold having a first portion of said first side [positioned against] bonded to a second portion of said first side by said adherent material; and

a second fold extending along the edge of said backing sheet contiguous with said first fold, said second fold having the first portion of said second side positioned against the second portion of said second side.

Claims 15-18 (Cancel)

Claims 21-31 (Cancel)